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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,036	04/12/2004	Vani S. Kathula	166538009US	4110
25096	7590	08/17/2006	EXAMINER	
PERKINS COIE LLP			DESTA, ELIAS	
PATENT-SEA			ART UNIT	
P.O. BOX 1247			PAPER NUMBER	
SEATTLE, WA 98111-1247			2857	

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/823,036

Applicant(s)

KATHULA ET AL.

Examiner

Elias Desta

Art Unit

2857

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-9 and 11-80.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

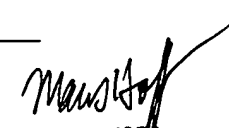
8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


MARC S. HOFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

Continuation of 11. does NOT place the application in condition for allowance because: See Continuation Sheet. In regard to the claim rejection - 35 U.S.C. 101: claims 1-9 and 11-80: In the instant application, "a method of scoring" does not appear to be used to manipulate tangible physical object and result in the object having a different physical attribute or structure. The computed or the score value mainly relay on the very nature of subjective judgment where the base and the maximum defect type are defined. The outcome is a computed score value based on subjective analysis; therefore, it is not consistent. An inconsistent method of scoring is not concrete, tangible or useful. As noted above, "a method of scoring" is a process that takes and compares the process outputs (based on subjective analysis) to the values of the last set of process inputs and storing the results of the comparison. At best, the instant method is more of a survey than a consistent and objective scoring method.

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. Referring to the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" in determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete."

In the instant application, the calculating step does not constitute a new or improved output that is considered useful, concrete and tangible.

Rejection under 35 U.S.C. 102

Unlike the Applicant's assertion, McDonald teaches "providing a defect type score range [peak score range as noted in table 6 of McDonald] ... and a maximum extent [peak score as noted in Table 5 of McDonald] that is specific to the defect type [better characterized in Table 12 of McDonald as "defect"] and calculating a score [cumulative, total, peak or condition rating] for the defect type based on the relationship between the extent of the defect type and the maximum possible extent of the defect type"(see McDonald, Tables 10, 11 and 12).

The instant application and McDonald include a defect type score method with category, form and severity of the defect type. These conditions are interpreted as the extent of the defect type. The method used by the instant application and McDonald uses a subjective assessment of a pipe inspection data by a qualified individual and subjected to the inspector's interpretation. The concept and the method of carrying the operation used in both the instant application and McDonald are substantially similar. The instant application may define certain terminologies to make the case; however, the basis for the identification of defective pipe is the same as the method used in McDonald.

Applicant's assertion that the instant application provides a method for "grading pipes using root-mean-square combination of the highest defect type score of the defect types and an average defect type score of the remaining defect types" is nothing more than a well known statistical analysis method. McDonald's summary (see page 368, section 4), which states that the collected data have been given assessment ratings, weights and scales that are used in most statistical analysis.